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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.
Plaintiff,
v.
GOOGLE INC.
Defendant

Case No. CV 10-03561 WHA

**ORACLE'S RESPONSE TO ORDER TO
SHOW CAUSE RE TECHNICALLY
NECESSARY COPYING (ECF No. 1765)**

1 Oracle's TX 5332 (attached as Ex. 1) sets forth specifically those 154 class, interface, and
 2 method declarations, found in 62 classes and interfaces (of 3 packages) of Java SE 5.0, that are
 3 constrained by the Java Language Specification, Third Edition. The Court's proposed order
 4 should be modified before it is entered because the *entirety* of the 62 classes is not constrained by
 5 the language, only the *particular code* listed on TX 5332. With that modification, the order
 6 should be entered as proposed by the Court.

7 For purposes of this case only, asserting Java SE 1.4 and 5.0, Oracle is willing to stipulate
 8 that these 154 lines of declaring code are technically constrained by the Java programming
 9 language, and therefore constitute a fair use in Android. In other words, Oracle stipulates only
 10 that use of *those specific lines* on TX 5332 is fair. It is important to note the distinction between
 11 the specific lines and the entirety of the 62 classes and interfaces, because the classes and
 12 interfaces are not constrained *in their entirety*. There are many declarations in these classes and
 13 interfaces (at a rough estimate a total of more than 900), and the rest are not constrained at all by
 14 the language specification. Neither the literal elements nor SSO for the remainder of those
 15 classes and interfaces is constrained by the language. The Court's order should establish that the
 16 contents of TX 5332, and only the contents of TX 5332, is constrained by the language.

17 With this modification, the Court's proposed order will reflect Oracle's stipulation as it
 18 was offered. Oracle has also moved to exclude any evidence or argument inconsistent with the
 19 stipulation on the ground that Google has no such contrary evidence and any contrary argument
 20 would be irrelevant, misleading and unduly consumptive of time. Fed. R. Evid. 402, 403. The
 21 Court has the power to enter the stipulation offered by Oracle and to order Google not to vary the
 22 terms of the stipulation.

23 The Java Language Specification, Third Edition, specifies the Java programming language
 24 associated with the Java SE 5.0 platform. Oracle's experts Dr. Mark Reinhold and Dr. Douglas
 25 Schmidt analyzed the language specification to determine exactly what in the API was expected
 26 by the language and therefore technically constrained by the language. As they explain, because
 27 the language specification only expects to find certain specific classes and interfaces in particular
 28 packages with a particular access modifier, that specification dictates only the name of the class,

1 interface, or method, whether it is defined public or protected, and in which package it is located.
 2 Accordingly, it is only those specific portions of the 154 declarations from the 62 classes and
 3 interfaces—namely, the class/interface name, public vs. protected designation, and in which
 4 package it is located—that are technically required when programming in the Java language.

5 No other aspect of those 62 Java classes and interfaces is dictated or constrained by the
 6 Java language specification. Google's technical expert agrees. Ex. 2 (Astrachan Depo.) 158: 13-
 7 20 (Q: ... I'm asking you if there -- as you sit here today, can you identify anything specific in the
 8 Java API that is constrained by the language that is not expressed in that chart [Exhibit A]? A:
 9 No, I can't give you any of that information today."). Furthermore, Google's experts, including
 10 Dr. Astrachan, never analyzed whether copying any other part of the 37 Java API packages was
 11 required to make use of the Java programming language. *See* Ex. 2 (Astrachan Depo.) 157:7-10
 12 (Q: And have you made any effort to duplicate or verify or otherwise analyze that chart [Exhibit
 13 A]? A: No, I have not tried to duplicate.").

14 The approach Dr. Reinhold took in preparing TX 5332 is consistent with his approach and
 15 related testimony during the first trial: that mere mention of a class or interface in the Java
 16 Language Specification does not mean the entire class is constrained by the Java programming
 17 language. *See* Ex. 3 (Trial. Tr. Vol. 4) 678:17-677:2 (Q. Are any of the classes in the Java
 18 Application Programming Interface actually specified in the Java language specification? A. No.
 19 As the paragraph goes on to explain, the language definition constrains the behavior of these
 20 classes and interfaces, but this document does not provide a complete specification for them. Q.
 21 And where are you directed to find the complete specification? A. The reader is referred to other
 22 parts of the Java platform specification for such detailed API specifications.); *see also* Ex. 4
 23 (Reinhold Depo.) 105:8-106:23.

24 The Court can and should enter the stipulation and also order that Google cannot vary
 25 from it. Fed. R. Civ. P. 16, 26; Fed. R. Evid. 402, 403; *see Dukes v. Wal-Mart Stores, Inc.*, 222
 26 F.R.D. 137, 143 (N.D. Cal. 2004) (subsequent history and citation omitted) (trial courts have
 27 "inherent power to manage and control pending litigation"); *G. Heileman Brewing Co. v. Joseph*
 28 *Oat Corp.*, 871 F.2d 648, 650 (7th Cir. 1989) (court can order litigants under "inherent authority

1 to manage and control the litigation"); *Simon v. Philip Morris Inc.*, 200 F.R.D. 21, 26-27
 2 (E.D.N.Y. 2001) ("trial judges must assume the role of a litigation manager"; the court has the
 3 "inherent power to manage litigation") (citations omitted).

4 Oracle agrees the order should permit the parties to update and conform their expert
 5 reports to account for the Court's Order that copying the specific portions of lines of code from
 6 62 classes and interfaces identified in TX 5332 constitutes fair use. *See Newell Puerto Rico, Ltd.*
 7 *v. Rubbermaid Inc.*, 20 F.3d 15, 22 (1st Cir. 1994) ("It is not unusual for experts to make changes
 8 in their opinions and revise their analyses and reports frequently in preparation for, and
 9 sometimes even during, a trial."). Conforming expert reports to the current claims at issue will
 10 enable the parties' experts to better "help the trier of fact to understand the evidence or to
 11 determine a fact in issue," Fed. R. Evid. 702, and will avoid the confusion that would result if the
 12 reports were not conformed to this evidence. The Court should permit the parties to update the
 13 reports of the following expert witnesses, if desired, in light of this new information: Dr. Owen
 14 Astrachan, Dr. Chris Kemerer, Dr. Gregory Leonard, Mr. James Malackowski, Dr. Douglas
 15 Schmidt, and Mr. Robert Zeidman.

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Dated: May 3, 2016

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Respectfully submitted,

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Orrick, Herrington & Sutcliffe LLP

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By: /s/ Annette L. Hurst

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Annette L. Hurst

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Counsel for ORACLE AMERICA, INC.

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